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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,587	03/31/2004	David Stein	2006P26235 US	4314

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SIEMENS CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
170 WOOD AVENUE SOUTH
ISELIN, NJ 08830

EXAMINER

TURK, NEIL N

ART UNIT	PAPER NUMBER
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1797

MAIL DATE	DELIVERY MODE
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10/16/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/813,587

Applicant(s)

STEIN ET AL.

Examiner

Neil Turk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 13-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-12, drawn to an immunoassay analyzer, classified in class 422, subclass 67.
- II. Claims 13-20, drawn to a method of performing immunoassays, classified in class 436, subclass 47.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by hand, and also does not require the computer controller of the apparatus of group I.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

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During a telephone conversation with Chien Yuan on October 10th, 2007 a provisional election was made without traverse to prosecute the invention of group I, claims 1-12. Affirmation of this election must be made by applicant in replying to this Office action. Claims 13-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification does not provide proper antecedent basis for the various "means for" limitations recited throughout claims 1-12.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear how the samples are related to the test vessels. Claim 1 recites a means for loading one or more samples, as well as a means for identifying tests to be performed on each of the one or more samples, where each of the tests is to be performed in a test vessel. By this recitation of performing the test in a test vessel, there must be an established relationship between the samples and the test vessels. Otherwise, do the test vessels contain an additional different sample, which has not been recited in the claims? Does Applicant intend to recite something along the lines of “means for loading one or more samples into test vessels”? The further recitations in claim 1 regarding the moving and controlled movement of the vessels incur the same indefiniteness as established above.

Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims invoke 35 U.S.C 112, sixth paragraph, in several instances with use of “means for” language, however the specification does not provide support for the “means for” language used in the claims. For example, claim 1 recites “means for loading”, “means for identifying”, and “means for moving”. The specification does not generally recite any of the above “means for” phrases, nor does it

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provide for any specific structure that corresponds to any of the above “means for” phrases, as well as the other “means for” recitations throughout dependent claims 3-5.

Further, this interpretation is proper since the claim limitation recites “means for” language, and the “means for” is not modified by sufficient structure for achieving the specified function. A means-plus-function limitation recites a function to be performed rather than definite structure or materials for performing that function. For claims falling under 35 U.S.C. 112, sixth paragraph, Examiners are required to construe claims as covering the corresponding structure, material, or acts described in the specification and equivalents thereof, see *In re Donaldson Co.*, 29 USPQ2d 1845 (Fed. Cir. 1994). However, the specification does not set forth the corresponding structure. Thus, it is unclear and indefinite what structure Applicant is intending to encompass with the “means for” limitations recited throughout claims 1 and 3-5.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 2 recites determining a launch of test sequence for each test based on “samples under test” and “samples to be tested”. The terms “samples under test” and “samples to be tested” do not have antecedent basis in claim 1. Further, it is unclear how the controller determines a launch of test sequence for a sample that is already under test, and how a time and order for the tests to be launched is achieved with samples that are already under test. The claim language to the controller’s determination of a launch of test sequence is unclear with respect to the two

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types of samples. How does the controller determine a launch sequence for the samples? Additionally, the phrase "a launch of test sequence" is unclear. Does Applicant intend to recite, "a launch of a test sequence" or "a launch of test sequences"? Please clarify the language.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Hanawa et al. (5,972,295), hereafter Hanawa.

Hanawa discloses an automatic analyzing apparatus. Hanawa discloses a tray having many aligned sample racks 2 is loaded in a rack supply unit 1 (lines 22-30, col. 4, fig. 1). Hanawa also discloses a transfer line 3 that is composed of a belt line rotating upward and downward, and the transfer operation is controlled so that the sample rack stops at predetermined positions. Hanawa also discloses that the rack identifying unit 4 has a bar-code reader 5 for identifying a destination of the sample rack that comes to the entrance of the transfer line. Hanawa further discloses that the identifying apparatus may also be provided at the analyzing units 6, 14 or at the exit of the transfer line in addition to being at the rack identifying unit. Hanawa further discloses that the

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content of the bar-code label 87 of the rack and the bar-code label 86 of the sample containers are transferred to a control unit 50, and the rack kind, the kind of analysis item instructed to each of the sample containers, and other information is compared with analysis information pre-instructed from an operating unit 55. Based on the compared results, the destination of the sample rack 2 is determined by the control unit 50 and stored in memory for processing of the sample rack to be performed later (lines 38-60, col. 4, fig. 1). Hanawa discloses that the analyzer units 6 or 14 along the transfer line comprise a sampling area 8 or 16 for receiving a sample rack and returning the sample rack after pipetting processing (lines 8-27, col. 5, fig. 1). Hanawa further discloses that the control unit 50 judges whether or not the sample racks require analysis of a particular analyzer (or of an additional analyzer if previously analyzed at analyzer 6) or if a sample rack is to be returned for additional analysis (or reexamination), and the rack is directed along the appropriate path(s) as judged by the control unit in each case (columns 5&6, fig. 1).

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil Turk whose telephone number is 571-272-8914. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NT


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